# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 10/828,878 | 04/20/2004 | Yasuhiko Uchida | ITECP015 | 5596 |

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| EXAMINER |
|---|
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
| :--- | :--- | :--- |
| **Office Action Summary** | 10/828,878 | UCHIDA ET AL. |
| | Examiner | Art Unit | |
| | JONATHAN R. BECKLEY | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) ☒ Responsive to communication(s) filed on <u>27 February 2008</u>.

2a) ☒ This action is **FINAL**.  2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) ☒ Claim(s) <u>1,4-11 and 13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,4-11 and 13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

### Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>20 April 2004</u> is/are:  a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☒ Some *  c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>01/19/2006,04/21/2008</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.      **Claims 1, 4-11, and 13** are **rejected** under **35 U.S.C. 103(a)** as being

unpatentable over obviousness by **Morag (U.S. Patent Number 6,324,545 B1)** and

further in view of **Shaffer et al. (U.S. Patent 6,396,963)**.

3.      Regarding **Claim 1, Morag** teaches a print job creation apparatus that creates a

print job **(Column 1, lines 41-43)**, which includes layout of at least one image in a

template having at least one image integration area to integrate an image therein

**(Column 7, lines 17-23; Column 8, lines 7-17)**, said print job creation apparatus

comprising:

        a template selection module that selects a template in response to a user's

template selection instruction **(Column 8, lines 7-17 and 22-25)**;

        a priority order setting module that sets a priority order of at least one image

integration area included in the selected template, **(Column 7, lines 30-35; Column 9,**

**lines 13-22, Column 10, lines 49-59)**;

        an area displaying module that displays the priority order set by said priority

order setting module in at least one image integration area **(Column 2, lines 21-27;**

**and Column 3, line 2-3; Noted: A user using a computer to perform arrangement and processing would done by using a display of a computer)**;

a built-in image selection module that selects at least one image as a built-in image to be integrated into the selected template, in response to the user's image selection instruction **(Column 7, lines 41-42)**;

and an image integration module that integrates the at least one selected built-in image into the at least one image integration area of the selected template in the priority order set by said priority order setting module, in response to the user's image integration instruction **(Column 7, lines 39-40)**.

**Morag** does not clearly teach or directly disclose a priority set according to a positional sequence of an upper end and a positional sequence of a left end of each image integration area in the selected template;

and an area displaying module that displays the priority order set by said priority setting module in at least one image integration area.

**Morag combined with Shaffer** does teach a priority set according to a positional sequence of an upper end and a positional sequence of a left end of each image integration area in the selected template **(Shaffer: Column 12, lines 10-13; See Figure 8 example)**;

and an area displaying module **(Shaffer: computer terminal or kiosk, 28)** that displays the priority order set by said priority setting module in at least one image integration area **(Shaffer: Column 4, lines 47-48)**.

Morag and Shaffer are combinable due to the fact both disclosures are based upon image input and output systems, methods and apparatuses with image processing.

Therefore, it would have been obvious to one skilled in the art to modify Morag with the teachings of Shaffer, so to explain how a user is allowed to have an easy method for creating image files according to the user's preference using the methods.

Regarding **Claim 4, Morag** further discloses the template is prepared by setting at least one transparent area as the image integration area in an original template image, which has no image integration area **(Morag: Column 9, lines 49-53)**, and

said priority order setting module sets the priority order of the at least one image integration area, based on an arrangement of the at least one transparent area in the original template image **(Morag: Column 9, lines 45-48)**.

Regarding **Claim 5, Morag** further discloses the template is prepared by combining an original template image, which has no image integration area, with at least one area display image, which defines the at least one image integration area, and

said priority order setting module sets the priority order of the at least one image integration area, based on the at least one area display image **(Morag: Column 10, lines 49-59)**.

Regarding **Claim 6, Morag** further discloses the area display image is used to

set a transparent area corresponding to the image integration area in the original

template image **(Morag: Column 9, lines 45-53)**.


Regarding **Claim 8, Morag** further discloses an image replacement module that,

in response to the user's selection of one image integration area in the template with a

built-in image currently placed therein by said image integration module and an image

to be newly integrated into the selected image integration area, replaces the built-in

image currently placed in the selected image integration area with the selected image

**(Morag: Column 8, line 52 – Column 9, line 2)**.


Regarding **Claim 9, Morag** further discloses a print service selection module that

selects one print service among multiple print service options, in response to the user's

operation **(Morag: Column 9, lines 54-67)**; and

a template storage module that stores available templates corresponding to each

of the multiple print service options **(Morag: Column 12, lines 37-34)**,

wherein said template selection module displays a list of available templates

corresponding to a print service selected by said print service selection module, among

all the templates stored in said template storage module, to allow selection of a desired

template **(Morag: Column 12, lines 27-47)**.

Regarding **Claim 10, Morag** further discloses the multiple print services include

at least one of an enlargement printing service, a digest printing service, a calendar

printing service, a postcard printing service, a photo name card printing service, an ID

photograph printing service, a seal printing service, a label printing service, and an

album printing service **(Morag: Column 1, lines 41-51)**.

Regarding **Claim 11, Morag** teaches A print job creation method that creates a

print job **(Column 1, lines 41-43)**, which includes layout of at least one image in a

template having at least one image integration area to integrate an image therein

**(Column 7, lines 17-23; Column 8, lines 7-17)**, said print job creation method

comprising the steps of:

(a) selecting a template in response to a user's template selection instruction

**(Column 8, lines 7-17 and 22-25)**;

(b) setting a priority order of at least one image integration area included in the

selected template according to a positional  sequence of an upper end and a positional

sequence of a left end of each image integration area in the selected template **(Column**

**7, lines 30-35; Column 9, lines 13-22, Column 10, lines 49-59)**;

(b1) displaying the priority order set by said priority order setting module in the at

least one image integration area **(Column 2, lines 21-27; and Column 3, line 2-3;**

**Noted: A user using a computer to perform arrangement and processing would**

**done by using a display of a computer)**;

(c) selecting at least one image as a built-in image to be integrated into the selected template, in response to the user's image selection instruction (**Column 7, lines 41-42)**; and

(d) integrating the at least one selected built-in image into the at least one image integration area of the selected template in the priority order set in said step (b), in response to the user's image integration instruction**(Column 7, lines 39-40)**.

**Morag** does not clearly teach or directly disclose a method of (b) setting a priority order of at least one image integration area included in the selected template according to a positional sequence of an upper end and a positional sequence of a left end of each image integration area in the selected template;

(b1) displaying the priority order set by said priority order setting module in the at least one image integration area.

**Morag combined with Shaffer** does teach a method of (b) setting a priority order of at least one image integration area included in the selected template according to a positional sequence of an upper end and a positional sequence of a left end of each image integration area in the selected template; **(Shaffer: Column 12, lines 10-13; See Figure 8 example)**;

(b1) displaying the priority order set by said priority order setting module in the at least one image integration area. **(Shaffer: Column 4, lines 47-48)**.

Morag and Shaffer are combinable due to the fact both disclosures are based upon image input and output systems, methods and apparatuses with image processing.

Therefore, it would have been obvious to one skilled in the art to modify Morag

with the teachings of Shaffer, so to explain how a user is allowed to have an easy

method for creating image files according to the user's preference using the methods.


Regarding **Claim 13, Morag** further discloses the step of: in response to the

user's selection of one image integration area in the template with a built-in image

currently placed therein in said step (d) and an image to be newly integrated into the

selected image integration area, replacing the built-in image currently placed in the

selected image integration area with the selected image **(Morag: Column 8, line 52 –**

**Column 9, line 2)**.


4.      **Claim 7** is rejected under **35 U.S.C. 103(a)** as being unpatentable over

obviousness by **Morag (U.S. Patent Number 6,324,545 B1)**.

5.      Regarding **Claim 7**, **Morag** does disclose the generation of images by computer

**(Column 1, lines 15-16)**.  These images would be known to one of ordinary skilled in

the art as binary images.

However, **Morag** does not directly disclose the area display image is a one-pixel-

one-bit image having one-bit information for each one pixel, which represents either a

bit-on or a bit-off to show inclusion into or exclusion from an image integration area.

Therefore it would have been obvious to one of ordinary skilled in the art at the

time the invention was made to understand that when images to be displayed are

generated by a computer or processor, that in order to do so, one would be using the

teachings and knowledge of binary images on a computer.


## *Response to Arguments*

6.      Applicant's arguments filed 02/27/2008 have been fully considered but they are

not persuasive.

With respect to the applicant's arguments and remarks regarding Claims 1 and

11 that Morag does not disclose (or suggest) setting a priority order of at least one

image integration area according to a positional sequence of an upper end and a

positional sequence of a left end of each image integration area in a selected template.

In reply:  Morag does teach and disclose setting a priority order of at least one

image integration area.  Morag discloses" images are assigned a grade which indicate

the importance of them staying in order...."  Morag explains a user selects the

determination of the grade, and also an automatic method of choosing the grade.  From

the user automated and automatic automated methods it would be understood that the

positional sequence of upper and left could be used accordingly to preference.  Further

example is proven by the example of the display screen shown by the disclosure of

Shaffer.  Also, in reply to the amendments added to the applicant's claim 1, Morag

discloses a user uses a computer to make changes throughout the process and that the

automated method is performed on the computer which would clearly explain a display

device.  Further to explain a computer having a display device it is shown by the

teachings of Shaffer that the terminal or kiosk has a display as shown in the figures.

Morag clearly teaches and discloses setting a priority order of at least one image

integration area according to a positional sequence of an upper end and a positional

sequence of a left end of each image integration area in a selected template.

Noted: The applicant may not have understood or appreciated the invention of Ito

from the previous citations. The examiner has provided further explanations and

citations to where Morag, and Morag combined with Shaffer teaches and discloses the

applicant and gives examples of how the invention of Ito can be used to anticipate the

applicant. Therefore, Claims 1, 4-11, and 13 respectfully stand rejected.


### Conclusion

7.     **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JONATHAN R. BECKLEY whose telephone number is

(571)270-3432. The examiner can normally be reached on Mon-Fri: 7:30-5:00 EST

(Alternate Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, TWYLER L. HASKINS can be reached on (571)272-7406. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jonathan R Beckley/
Examiner, Art Unit 2625
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6/4/08

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